

REMARKS

Claims 1, 3, 11, 13, 19, and 21-23 are pending in the present application. Applicant amends independent Claims 1, 11, and 19 to clarify claimed subject matter and/or correct informalities. The original specification and drawings support these claim amendments at least at page 6, paragraph [0011], pages 11-12, paragraph [0023], and in Figures 5 and 8. Therefore, these revisions introduce no new matter.

Claims 1, 3, 11, 13, 19, and 21-23 are pending for consideration upon entry of the present amendment. Claims 4-10 and 14-18 have been previously withdrawn, but depend from independent Claims 1 and 11, which are in allowable form after this response. Applicant respectfully requests rejoinder of the withdrawn claims, reconsideration, and allowance of the subject application in view of the foregoing amendments and the following remarks.

Interview Attempts

Applicant contacts the Examiner on August 1, and 2, 2007 by telephone and email to schedule an interview to discuss the claims. The Examiner refuses to schedule the interview, stating there is not sufficient time, since the end of the fiscal year is approaching (September 30, 2007).

Claim Rejections 35 U.S.C. §112, 1st and 2nd paragraphs

A. Claims 1, 3, 11, 13, 19, and 21-23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

B. Claims 1, 3, 11, 13, 19, and 21-23 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully traverses these rejections.

Without conceding the propriety of the stated rejections, and only to advance the prosecution of this application, Applicant amends the claims to clarify the subject matter and support may be found at pages 6, 11, 12 and Figures 5 and 8.

Independent Claim 1 now recites a fish tape, comprising:

a longitudinal portion comprising a circular outer diameter, and defining a solid substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the solid substantially cylindrical shape comprises a spiral groove defined along the circular outer diameter and extending along the longitudinal portion; wherein the longitudinal portion of the fish tape comprising the spiral groove allows the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis of the cylindrical shape;

an end portion comprising a plurality of grooves extending from the end portion at least partially along the longitudinal portion, wherein the end portion is attached to the longitudinal portion;

wherein the plurality of grooves in the end portion provide one or more mechanisms for attaching a plurality of wire or cable engaging attachments to the end portion of the fish tape.

First, the Office states it is unclear if the end portion is the same or different from the spiral groove. Applicant amends the claims to show these are different

grooves. For example, the amended claims state “the longitudinal portion of the fish tape comprising a spiral groove” and “the end portion comprising a plurality of grooves”. Thus, this shows there is a spiral groove on the longitudinal portion and a plurality of grooves on the end portion (88 in Figure 8 and 53 in Figure 5).

Next, the Office states it is unclear how the spiral groove at the end interacts with the end portion. Applicant amends the claims to recite “wherein the end portion is attached to the longitudinal portion” (paragraph [0023]).

Furthermore, the Office states it is not apparent how wires are to be attached to the fish tape such that the wires can be pulled by the fish tape. Applicant amends the claims to state “the plurality of grooves in the end portion provide one or more mechanisms for attaching a plurality of wire or cable engaging attachments to the end portion of the fish tape”. The original specification and drawings support these claim amendments at least at page 6, paragraph [0011], pages 11-12, paragraph [0023], and in Figures 5 and 8. Therefore, these revisions introduce no new matter.

Independent Claims 11 and 19 are directed to a fish tape device and a fish tape, respectively, and each is allowable for reasons similar to those discussed above with respect to Claim 1.

Dependent Claims 3, 13, and 21-23 depend directly or indirectly from one of independent Claims 1, 11, and 19, respectively, and are allowable for reasons similar to those discussed above with respect to Claim 1. Applicant respectfully

submits that these claims now comply with §112, first paragraph and second paragraph, and requests that the §112 rejections be withdrawn.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1, 3, 11, 13, 19, 21, 22, and 23 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over U.S. Patent Number 5,505,432 to Noonan in view of U.S. Patent Number 4,926,518 Mikol. Applicant respectfully traverses this rejection.

References Fail to Teach or Suggest Spiral Groove, Substantially Flex

First, Applicant asserts the Office has failed to establish a *prima facie* case of obviousness. Noonan fails to teach or suggest “a spiral groove defined along the circular outer diameter and extending along the longitudinal portion; the longitudinal portion of the fish tape comprising the spiral groove allows the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis”, as recited in Applicant’s independent Claims 1, 11, and 19.

Noonan is directed to a fish tape with “an anti-snagging” device (Abstract). In Noonan, the device comprises a roller to ride over discontinuities along the interior surface of the conduit (Noonan, col. 2, lines 19-24). In contrast, Applicant’s Claim 1 recites “a spiral groove defined along the circular outer

diameter and extending along the longitudinal portion; wherein the longitudinal portion of the fish tape comprising the spiral groove allows the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis". Thus, Noonan fails to teach or suggest the recited features of Applicant's Claim 1.

Non-analogous Art

Second, Applicant traverses the rejection of these claims because Mikol is non-analogous art. Mikol fails to compensate for the deficiencies of Noonan. For the purposes of evaluating obviousness of claimed subject matter, the particular references relied upon must constitute "analogous art" (MPEP §2141.01(a)). The art must be from the same field of endeavor, or be reasonably pertinent to the particular problem with which the inventor is involved.

Regarding the first prong of the above analysis, Mikol is not from the same field of endeavor as the Applicant's subject matter. Mikol is directed to a drain auger cleaning device. The device in Mikol cleans out tubes or pipes manually or by machine. In contrast, Applicant's subject matter pertains to fish tapes used to pull wires through conduits or other raceways. Thus, Mikol is clearly not from the same field of endeavor as is Applicant's subject matter.

Turning now to the second prong of the above analysis, Mikol is not reasonably pertinent to the particular problem with which Applicant is involved.

Rather, Mikol is an auger cleaning device to scrape the drainpipe free from obstructions and debris buildup. In Mikol, the auger is rotated manually or with use of a motor to scrape the drainpipe. In contrast, Applicant's subject matter pertains to using fish tapes to pull wires through conduits or other raceways. Thus, the device in Mikol does not address the problem of pulling wires through an area that may not be accessible, such as conduits or other raceways. As such, Mikol is not reasonably pertinent to the particular problem addressed by Applicant.

Because Mikol fails both prongs of the above analysis, Mikol is non-analogous art, and any §103 rejection based on Mikol is improper. On at least this basis, Applicant requests reconsideration and withdrawal of the stated §103 rejections.

There is No Motivation to Combine Noonan and Mikol

Third, Applicant asserts there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (MPEP §2142). The Office stated the motivation for providing a spiral groove of Mikol on the exterior of Noonan would have been obvious "to provide the flexibility necessary for the fish tape to be rotated, twisted and contorted within a pipe" (Action, page 3). Applicant respectfully disagrees.

Applicant submits that this motivation is not well reasoned, because there is nothing in either of the references that would suggest or need this motivation. Instead, Noonan states the fish tape “rides over” sharp edge, and other conduit configurations, such as a bend. In Noonan, the device “rides” around such a curvature in the conduit passage (Noonan, col. 4, lines 3-10). Thus, there is no need to provide a spiral groove on the device in Noonan. Rather, the device in Noonan already “rides” around curvatures and bends (Noonan, col. 4, lines 3-10). Thus, this combination of the references is not necessary.

Applicant asserts neither Noonan nor Mikol, alone or in combination, teaches or suggests the recited features of independent **Claims 1, 11, and 19**. Additionally, Mikol is non-analogous art, relative to the claimed subject matter. Finally, Noonan and Mikol are not properly combined under §103.

Dependent Claims 3, 13, and 21-23 depend directly or indirectly from one of independent Claims 1, 11, and 19, respectively, and thus are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those recited in Claims 1, 11, and 19, are not taught or suggested by Noonan or Mikol.

Accordingly, Noonan and Mikol do not support a §103 rejection. Applicant thus requests reconsideration and withdrawal of the stated rejection.

Conclusion

Claims 1, 3, 11, 13, 19, and 21-23 are in condition for allowance. Applicant respectfully requests rejoiner of the withdrawn claims, reconsideration, and allowance of the subject application. If any issue remains unresolved that would prevent allowance of this case, the Office is requested to contact the undersigned attorney to resolve the issue.

Respectfully Submitted,

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